

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has amended claims 15 and 20; no new matter has been added. Claims 11-20 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Allowable Subject Matter

The Examiner objected to claims 15 and 20 as being dependent upon rejected base claims, but indicated those claims would be allowable if rewritten in independent form, including all of the limitations of their base claims and any intervening claims. The Applicant has amended 15 to include the limitations of claim 11 and intervening claim 14, and amended claim 20 to include the limitations of claim 16 and intervening claim 19. Accordingly, claims 15 and 20 are now allowable.

3.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 11-13 and 16-19 as being unpatentable over Kubo, *et al.* (US 6,249,682 B1) in view of Takano, *et al.* (US 7,103,376 B2); and claims 14 and 19 as being unpatentable over Kubo in view of Takano and further in view of Yamamoto (US 2002/0013156 A1). The Applicant traverses the rejections.

a. Finality of Office Action is Premature Due to Examiner's Error

In the prior Office Action, the Examiner first rejected the claims as being unpatentable over Kubo in view of "**Takano et al.; US Patent No.: 7,103,376 B2).**" In response to the Examiner's rejection, the Applicant submitted arguments based, in part, on the fact that **US Patent No.: 7,103,376 B2** fails to teach what the Examiner alleged. In the present Final Office Action, the Examiner rejected Applicant's statements with respect to Takano.

Upon review of the file history in this case, the Applicant believes the Examiner's rejection was intended to be based on **U.S. Patent No. 5,924,043 A, also issued to**

Takano, which the Examiner listed on the Notice of References Cited with the prior office action. (Hereinafter, the Applicant will refer to US Patent No.: 7,103,376 B2 as Takano I and U.S. Patent No. 5,924,043 A as Takano II.) **Thus, based on the Examiner's failure to properly cite the reference upon which she apparently relied, the Applicant was denied the opportunity to present appropriate arguments to traverse the Examiner's rejection. Therefore, the Examiner should withdraw the finality of the present Office Action.**

The Applicant reasserts his prior arguments that Takano I fails to teach what the Examiner has claimed. In the remarks that follow, the Applicant provides further reasons for why the claims are also patentable over Takano II.

b. Examiner's Finding of Obviousness is Conclusory

In rejecting Applicant's claims a 11 and 16 over Kubo in view of Takano II, the Examiner recognizes that Kubo fails to teach "a memory for storing the sequence of transmit power control commands and a logical filter circuit for determining a radio signal strength minimum in the radio signal at a location of the mobile telecommunication device by detecting if a predetermined number of consecutive power control commands from the sequence of transmit power control commands each comprise either an 'up' or 'down' transmit power control command." To overcome the deficiencies of Kubo, the Examiner looks to "related art concerning a method and apparatus for controlling transmission power in a cellular mobile communication system," apparently referring to Takano II.

The Examiner asserts that Takano II teaches the claimed "logical filter circuit for determining a radio signal strength minimum in the radio signal . . . (column 13, lines 16-24)." The Applicant has reviewed the referenced portion of Takano II, and what Takano teaches there is the "detection of the motion speed, fDT, of a mobile unit." (See column 13, line 9, *et seq.*) Takano II does not refer to determining a radio signal strength minimum, as recited in claims 11 and 16. Therefore, Takano fails to overcome the deficiencies of Kubo.

Even if Takano II taught what the Examiner has asserted, the Examiner has not provided any basis for combining the teachings of those references to arrive at the claimed invention. The Examiner has merely looked for the disclosure of each claim element in the teachings of Kubo and Takano II, without any regard for the cooperation between claim elements, much less any suggestion in either of those references to combine their teachings to solve the problem addressed by Applicant's invention. The Examiner provides no support for the conclusory statement of obviousness; the Examiner merely states that "[i]t would have been obvious . . . to combine Kubo's apparatus and method for combining speed in a mobile communication with Takano's sequence storage and detection of power control commands in order to calculate the speed of the mobile unit." The Examiner, however, provides no motivation for such combination. As stated in MPEP §706.02(j):

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention **or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.**" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

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It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. (emphasis added)

Whereas the Examiner has not provided any reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious, the Examiner has failed to establish a *prima facie* case of obviousness of claims 11 and 16. Furthermore, whereas claims 12-14 and 17-19 are dependent from claims 11 and 16, respectively, and include the limitations thereof, those claims are also not obvious over Kubo in view of Takano II.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 11-20.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger Burleigh", written over the printed name.

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